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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,798	10/07/2003	Eric G. Hull	427600700079	4812

7590

10/18/2006

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EXAMINER

ELOSHWAY, NIKI MARINA

ART UNIT

PAPER NUMBER

3781

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,798

Applicant(s)

HULL ET AL.

Examiner

Niki M. Eloshway

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-27, 36, 38 and 39 is/are allowed.
- 6) ☒ Claim(s) 1-8, 10 and 28-35 is/are rejected.
- 7) ☒ Claim(s) 9 and 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The terminal disclaimer filed on August 7, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 11/014,136 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Objections

2. Claim 37 is objected to because of the following informalities:

(a) On line 1 of claim 37, "having" should be replaced by --having--, and

(b) On line 5 of claim 37, "depteh" should be replaced by --depth--.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinnard (U.S. 2,154,310) in view of Bordwell (U.S. 5,191,171). Kinnard discloses the claimed invention except for the greater depth being opposite the tangent location. As seen in figure 6 of Kinnard, the greatest depth is at the tangent location. Bordwell teaches that it is known to provide an area of increased thickness at the tangent (see element 46). It would have been obvious to one having ordinary skill in the art at the time

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the invention was made to provide the wall and container structure of Kinnard with the tangent location having increased thickness, as taught by Bordwell, in order to allow the knockouts to hinge instead of becoming completely removed.

5. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinnard (U.S. 2,154,310) in view of Bordwell (U.S. 5,191,171), as applied to claim1 above, and further in view of Weiss et al. (U.S. 6,765,147). The modified device of Kinnard discloses the claimed invention except for the slot. Weiss et al. teaches that it is known to provide a knockout with a slot (see element 30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified device of Kinnard with the slot of Weiss et al., in order to securely receive the tip of a screwdriver.

6. Claims 28-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinnard (U.S. 2,154,310) in view of Gehrs et al. (U.S. 5,444,183). Kinnard discloses the claimed invention except for the plastic material. Gehrs et al. teaches that it is known to form an enclosure of plastic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the wall and container structure of Kinnard made of plastic, as taught by Gehrs et al., in order to form the container of an inexpensive, lightweight material.

Allowable Subject Matter

7. Claims 11-26, 36, 38 and 39 are allowed.

8. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claim 37 is objected to as having minor informalities but would be allowable if appropriate corrections are made.

Response to Arguments

10. Applicant's arguments filed August 7, 2006 have been fully considered but they are not persuasive. Applicant argues that the grooves of Kinnard do not have a varying depth. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the depth of the grooves gradually varies around their circumference between the minimum and maximum depth locations) are not recited in all of the claims rejected over Kinnard. This limitation was presented only in original claim 36, currently amended claims 9, 11, 18 and 21 and newly presented claim 37. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Kinnard does, however, teach grooves with varying depths. Specifically, grooves 43 and 44 have a minimum depth at lead lines 43 and 44 in figure 6 and extend to a maximum depth at the tangent location. Although the depth does not appear to be gradually increasing along an inclined arcuate path, the depth is varied along the circumference.

Bordwell also does not teach a groove which is gradually increasing along an inclined arcuate path. Bordwell, however, does teach that it is known to provide an area of maximum wall thickness (or minimum groove depth) at the tangent location. The tangent location of Bordwell is the severable area which provides the most resistance. This is the teaching used to modify the Kinnard reference. The modification requires the minimum groove depth (or severable area providing the most resistance) to be located at the tangent location, as taught by Bordwell.

11. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to

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do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to modify the Kinnard reference is found in Bordwell, which teaches that a stronger connection at the tangent aids in preventing the outer knockout from becoming displaced.

12. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the grooves have common minimum depths) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Kinnard does teach that the grooves have a common maximum depth.

13. In response to applicant's argument that the slot of Weiss et al. cannot be provided on the device of Kinnard, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

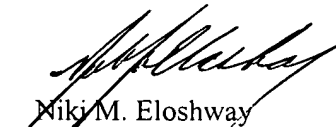
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shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

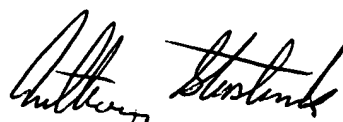
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niki M. Eloshway whose telephone number is 571-272-4538. The examiner can normally be reached on Thursdays and Fridays 8 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Niki M. Eloshway
Examiner
Art Unit 3781

nme


ANTHONY D. STASHICK
PRIMARY EXAMINER